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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,276	11/10/2003	Toru Ichiki	03676/LH	4894

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FRISHAUF, HOLTZ, GOODMAN & CHICK, PC
220 Fifth Avenue
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NEW YORK, NY 10001-7708

EXAMINER

ZHANG, FAN

ART UNIT	PAPER NUMBER
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4157

MAIL DATE	DELIVERY MODE
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10/23/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/705,276

Applicant(s)

ICHIKI, TORU

Examiner

Fan Zhang

Art Unit

4157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date Nov 10, 2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akiyama et al (Pub No. US2002/0015182) further in view of Tverskoy et al (Patent No. US 6,341,160).

The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- a. Determining the scope and contents of the prior art;
- b. Ascertaining the differences between the prior art and the claims in issue;
- c. Resolving the level of ordinary skill in the pertinent art; and
- d. Evaluating evidence of secondary considerations for indicating obviousness or nonobviousness.

For claim 1, Akiyama and Tverskoy et al teach the following as claimed:

An image forming apparatus (Akiyama: fig. 1, "Summary of the Invention"), comprising:

(a) a communication device for communicating with an external apparatus according to a communication procedure by a facsimile (Akiyama: fig. 1, also [0039-0041] i.e. communication with external telephone 4 via PSTN subscriber line3);

(b) a data processor for picking up image data and communication control data by decoding facsimile communication data from the external apparatus received by the communication device (Akiyama: fig. 1, i.e. CPU 11 serves this purpose. For details, see also fig. 4);

(c) a memory for storing the image data obtained by the data processor, by associating with identification data to identify the image data (Akiyama: fig. 1, i.e. image storage section 15 serves this purpose);

(d) an image output device for forming and outputting an image based on the image data (Akiyama: fig. 1, i.e. printer 18 serves this purpose);

(e) an identification electronic mail creating device for creating an identification electronic mail for demanding an image data processing format to be set, by notifying that, when communication control data has been obtained by the data processor, facsimile communication data to be sent to a predetermined electronic mail address has been received, and also by notifying image data identification data (Akiyama: fig. 1, mail server 6. Tverskoy et al: "Specifically, control system 26 generates an e-mail message for each voice message stored in memory 22. Each e-mail message has a header conveying information about the voice message", line 62-67 of section 4. Although electronic mails created from Akiyama and Tverskoy et al's devices do not carry the exactly same information as specified in the claim, they bear the same structure that would inherit all the claimed functional limitations);

(f) a transmission and reception device for transmitting the identification electronic mail to a predetermined external terminal and for receiving an instruction electronic mail containing an instruction on a processing format for the image data and the identification data from the

Art Unit: 4157

external terminal (Akiyama: fig. 4 for mail transmission process and fig. 5 for mail reception process. Tverskoy et al: "To provide this access, answering machine 12 sends and receives electronic mail messages to and from the user", line 46-51 of section 3; "The user may also generate e-mail messages containing commands to be executed by answering machine 12", line 62-67 of section 5 and line 12-67 of section 6).

(g) an electronic mail processor for extracting the instruction on the image data processing format and the identification data from the instruction electronic mail from the external terminal (Akiyama: see [0058, 0067], also figs. 4-5, i.e. the CPU 11 serves as the electronic mail processor, and the mail server 6 serves as the external terminal. Tverskoy et al: line 1-11 of section 6); and

(h) an image data processor for sending to the image output device an output image data which is obtained by processing so that the image data specified according to the extracted processing format is outputted according to the processing format (Akiyama: see [0071, 0078, 0085, 0087] i.e., the CPU 11 also serves this purpose).

For claim 2, the image forming apparatus of claim 1, further comprising a transmission table for storing an electronic mail address in association with the transmitter of the facsimile communication data included in the communication control data, wherein the identification electronic mail device extracts the electronic mail address where the identification electronic mail is sent by referring to the transmission table based on the transmitter to create the identification electronic mail. (Akiyama further teaches this aspect. See figure 2, paragraphs [0046] and [0050], a recipient-address storage area is reasonable interpretation of "transmission table" as claimed).

For claim 3, the image forming apparatus of claim 1, further comprising a processing table for storing a transmitter of the facsimile communication data included in the communication control data, and information on whether the image data corresponding to the communication control data should be sent to the image output device or the memory, wherein the data processor sends the image data to a predetermined receiver by referring to the processing table, based on the transmitter. (Akiyama el at teaches in paragraphs [0052] and [0053] a communication capability storage section as a reasonable interpretation of “processing table” claimed).

For claim 4, the image forming apparatus of claim 1, further comprising an input device for specifying a voluntary receiver to which an identification electronic mail is sent, when the identification electronic mail creating device creates the identification electronic mail. (Akiyama el at teaches in paragraph [0044] an operation/display section for receiving user’s instructions. Although it does not explicitly point out the functions as described in claim 4, these functions would have been implied and expected as they are capabilities common to the structure of a key input device. In addition, Tverskoy el at: teaches in line 51-57 of section 2 a personal computer connected to an answering machine to allow user to enter email account identification).

For claim 5, the image forming apparatus of claim 1, further comprising a deletion device for deleting the image data output. (Tverskoy el at teaches in line 12-22 of page 6 a device for deleting data as claimed).

For claim 6, the image forming apparatus of claim 5, where in image data processing format is one of printing, facsimile sending, e-mail sending and deleting, or a combination

Art Unit: 4157

thereof. The recited limitations as claimed have been analyzed and rejected with respect to claims 1-5 above.

In summary, Akiyama et al teaches a facsimile apparatus for image communication comprising structure limitation of claim 1, 2, 3, and 4. Akiyama differs from the claimed invention in that its transmitted and received electronic mails do not carry the same information as described in the claimed invention (claim 1(e)), nor does it disclose a device for deleting data output (claim 5 and 6). However, Akiyama's invention possesses the same email creating structure that has inherent functional capabilities of the claimed invention. And the conceptual ideas as prescribed in claim 5 and 6 are made known as evidenced in Tverskoy et al. Specifically, Tverskoy et al teaches an electronically accessible answer machine that generates an electronic mail corresponding to a stored voice message and sends the mail to user. The user may reply an email containing commands (such as deleting data output) to be executed by answering machine.

Therefore, considering the combined teaching of Akiyama and Tverskoy as a whole, the concept and advantage of including a device for executing a user command such as deleting data output would have been obvious to one of ordinary skills in the art.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tsukui et al. (US Pub 2002/0051183) teaches an internet facsimile machine and related mail/image printing method.

Gifford et al. (US Patent 6,549,612) teaches utilization of an active interface embedded in an email notification to control the delivery of non-literal messages that include but not limited to facsimile image data.

Bobo, II (US Patent 5,675,507) teaches a Message Storage and Deliver System receives and stores facsimile messages and receives a request from a user for retrieving messages from storage area.

Mochizuki (US Patent 6,101,526) teaches a data communication apparatus and method for reducing a load on a mail server by transmitting image data based on the contents of an electronic mail.

Tanimoto (US Pub 2003/0020960) teaches an internet facsimile machine having an ability exchanging function for forming an electronic mail.

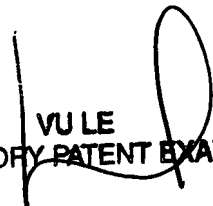
Contact

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fan Zhang whose telephone number is (571) 270-3751. The examiner can normally be reached on Mon-Fri from 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Vu Le can be reached on (571) 272-7332. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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SUPERVISORY PATENT EXAMINER